

REMARKS

This is a response to the Office Action dated August 26, 2004.

Claims 1-72, 74-77 and 81-83 have been provisionally rejected under the doctrine of obviousness-type double patenting in view of the claims of the parent case, app. no. 09/808,807. Applicants are submitting a Terminal Disclaimer herewith to remove the rejection.

Claims 78-80 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent 6,371,907 to Hasegawa et al. in view of JP 58-172905. U.S. patent 6,371,907 was also cited in the parent case, app. no. 09/808,807. In the parent case, this patent was removed as a reference after Applicants noted a common ownership.

Similarly, here, Applicants note that U.S. patent 6,371,907 is commonly owned with the present application by the assignee Olympus Optical Co., Ltd. Of Tokyo, Japan. Specifically, Applicants note that U.S. patent 6,371,907 is a reference only under 35 U.S.C. § 102(e) because the U.S. filing date of the parent application, app. no. 09/808,807, is March 15, 2001, which is before the publication date of April 16, 2002 of U.S. patent 6,371,907. JP 58-172905 is a reference under 35 U.S.C. § 102(b) since it was published more than one year before the filing date of app. no. 09/808,807.

Under 35 U.S.C. § 103(c):


Subject matter developed by another person, which qualifies as prior art only under one or more subsections (e), (f) and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

The present invention, app. no. 10/660,383, was commonly-owned with subject matter of app. no. 09/808,807 by the Olympus Optical Co, Ltd. of Tokyo, Japan at the time the present invention was made, as documented by the U.S. Patent and Trademark Office Notice of Recordation of Assignment recorded July 16, 2001 for app. no. 09/808,807 at Reel 011980, Frame 0438. The assignment for app. no. 09/808,807 carries over to the present app. no. 10/660,383, which is a continuation of app. no. 09/808,807, under MPEP 306. See the enclosed STATEMENT OF COMMON OWNERSHIP TO DISQUALIFY A REFERENCE UNDER 35 USC § 103(c)

Therefore, under the provisions of 35 U.S.C. § 103(c), Applicants respectfully request the Examiner to remove U.S. patent 6,371,907 as a reference. Accordingly, the rejection under U.S. patent 6,371,907 to Hasegawa et al. in view of JP 58-172905 must also be removed.

Accordingly, Applicants respectfully submit that the present application is in condition for immediate allowance. Early and favorable consideration of the present application is respectfully requested.

Respectfully submitted,


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Encl. (Statement of Common Ownership to Disqualify
a Reference Under 35 U.S.C. § 103(c) and a
Terminal Disclaimer)